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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,669	01/29/2004	Hideo Kawata		2800

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JAPAN

EXAMINER
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DIAMOND, ALAN D

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/766,669

Applicant(s)

KAWATA, HIDEO

Examiner

Alan Diamond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an applications filed in Japan and WIPO on July 5, 2001, January 31, 2002, and January 22, 2003. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on these applications, since the United States application was filed more than twelve months thereafter. Accordingly, the instant application has a U.S. filing date of January 29, 2004, with no foreign priority date.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the date at which the declaration was signed is not provided. Note on page 2 of the declaration, to the right of the "Inventor's Signature" box, the "Date" box is empty.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference characters 1, 2, 3, and 4 in Drawing 1. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the

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immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to because in the Drawing 1 at the right-side of the page, the "3.4" in the box should be changed to "3,4". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

5. A substitute specification, i.e., the abstract and specification, in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed **must** be accompanied by a statement that it contains no new matter. Please note that the abstract and specification are replete with idiomatic errors.

6. The disclosure is objected to because of the following informalities: The specification is missing a "Brief Description of the Drawings" section (See, for example, col. 1, line 48 through col. 2, line 6, of U.S. Patent 6,617,506). Furthermore, Drawings 1 and 2 have not been described in the "Detailed Description" section of the specification. Appropriate correction is required.

### ***Suggestion for the Abstract***

7. It is suggested that the numbers 1, 2, 3, and 4, and the numbers in parenthesis (1), (2), (3), (4), and (5) in the abstract be changed to I, II, III, and IV, and (a), (b), (c), (d), and (e), respectively, in order to avoid any confusion with reference characters 1, 2, 3, and 4 in Figure 1.

### ***Comments***

8. The Examiner acknowledges that there is only one claim in the application. For the purposes of Examination, this claim is referred to as claim 1.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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10. Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph. The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one-sentence form only. Note the format of the claims in the patent(s) cited.

Please note that the instant claim has three sentences. The claim must be in one-sentence form only.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim. In particular, the claim is omnibus because, in order to set forth the invention, the claim cites "Jitugan 2001-005291 Solar-System Movable Mount" at the first, third and fifth lines of the claim. It is not clear what is to be encompassed by "Jitugan 2001-005291 Solar-System Movable Mount".

Claim 1 is indefinite because it is not clear what the structural cooperative relationship is between "the turning-over part" and "the elastic part" at the second line of the claim. It is not clear what these parts do or how they are connected and cooperate with each other.

Claim 1 is indefinite because the terms "the turning-over part" and "the elastic part" at the second line of the claim lack positive antecedent support in claim 1 itself. It

is suggested that these terms be changed to "a turning-over part" and "an elastic part", respectively.

Claim 1 is indefinite because the term "the set time" at the fourth line of the claim lacks positive antecedent support in claim 1. It is suggested that this term be changed to "a set time".

Claim 1 is indefinite because the term "the set position" at the sixth line of the claim lacks positive antecedent support in claim 1. It is suggested that this term be changed to "a set position".

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 61-194511, herein referred to as JP '511. JP '511 teaches a solar-system movable mount comprising a "turn-over" part, i.e., rotary shafts (1); and an elastic part, i.e. motor (4, 3). The motor (4, 3) is elastic in the sense that it is accommodating, i.e., it accommodates the position of the rotary shafts (1). In Figure 1, the rotary shafts (1) at least partly turn over the solar cell panels (2) (see Figure 1(a,b,c)). Clearly, the rotary shafts (1) and the

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motor (4, 3) move at the same time since the motor drives the shafts (see Figure 1).

Furthermore, said rotary shafts (1) and the motor (4, 3) stop at a set position (see the entire document, and in particular Figures 1 and 2). Since JP '511 teaches the limitations of the instant claim, the reference is deemed to be anticipatory.

13. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-102613, herein referred to as JP '613. JP '613 teaches a solar-system movable mount comprising a "turn-over" part, i.e., rotary shaft (13); and an elastic part, i.e. the motor and gears in box (16) (see Figure 1). Said motor/gears is elastic in the sense that it is accommodating, i.e., it accommodates the position of the rotary shaft (13). Clearly, the rotary shaft (13) and the motor/gears in box (16) move at the same time since the motor/gears drives the shaft (see Figure 1). Furthermore, said rotary shaft (13) and the motor/gear stop at a set position (see paragraph 0016). Since JP '613 teaches the limitations of the instant claim, the reference is deemed to be anticipatory.

14. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Sasaki, U.S. Patent 6,617,506. Sasaki teaches a solar-system movable mount comprising a "turn-over" part, i.e., horizontal axle (13); and an elastic part, i.e. support member (2) and gear (3) (see Figures 1-3, 9, and 10; and col. 4, lines 32-36). The support member (2) and gear (3) are elastic in the sense that they are accommodating, i.e., they accommodate the changing position of support stand (4), which rotates (see Figures 1 and 7). Clearly, the horizontal axle (3) and the support member (2)/gear (3) can move at the same time (see col. 3, line 49 through col. 4, line 12; col. 4, lines 32-36; and Figures 7 and 9). Furthermore, said rotary shaft (13) and the support member (2)/gear



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(3) stop at a set position (see Figures 9 and 10; and col. 4, lines 32-45). Since Sasaki teaches the limitations of the instant claim, the reference is deemed to be anticipatory.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Derwent Abstract 2003-627683 lists the family data for WO 2003/06540. The AU, WO and JP documents (listed in said Abstract) are not patents or inventor's certificates, and thus, do not qualify as prior art under 35 USC 102(d). JP 2000-223730 is hereby made of record.


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Diamond whose telephone number is 571-272-1338. The examiner can normally be reached on Monday through Friday, 5:30 a.m. to 2:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alan Diamond  
Primary Examiner  
Art Unit 1753

Alan Diamond  
January 21, 2005

A handwritten signature in black ink, appearing to read 'Alan Diamond', is written over the printed name and title.